

## REMARKS

In accordance with the foregoing, claims 1, 10, 12-15, 27, 39, 41 and 43 are amended. No new matter is being presented, and approval and entry of the amended claims are respectfully requested.

Claims 1-41 and 43 are pending and under consideration. Reconsideration is respectfully requested.

### ENTRY OF AMENDMENT UNDER 37 CFR §1.116

Applicant requests entry of this Rule 116 Response because it is believed that the amendment of claims puts this application into condition for allowance and should not entail any further search by the Examiner since no new features are being added or no new issues are being raised.

Claims 1, 27, 39, and 41 are amended to recite, respectively, that a method of adding background sound, an apparatus, and a voice mail platform, include, using claim 41 as an example, "looping the background sound." Dependent claim 10 is amended to correspond to base claim 1. Dependent claims 12-15 are amended to clarify a performing is by the "recipient" as recited by parent claim 11. Claim 43 is amended to correct an informality.

### ITEM 3: REJECTION OF CLAIM 26 UNDER 35 U.S.C. 102(e) AS BEING ANTICIPATED BY BALL ET AL. (U.S.P. 6,459,774)

The Examiner rejects claim 26 under 35 U.S.C. §102(e) as being anticipated by Ball et al. (U.S.P. 6,459,774).

Claim 26 recites a voice mail message, including "a message area containing at least a voice message and each of an audio stationary header preceding the message area, an audio stationary footer following the message area, and an audio stationary body occurring at least once in said message area in combination with the voice message." (Emphasis Added).

As provided in MPEP §706.02 entitled Rejection on Prior Art, anticipation requires that the reference must teach every aspect of a claimed invention. Applicant submits that Ball does not support an anticipatory-type rejection by not teaching features recited in claim 26.

Ball does not teach each of the four claimed features of 1) voice mail message area, 2) an audio header preceding the message area, 3) an audio footer following the message area, and 4) an audio body in the message area.

The Examiner incorrectly contends that these features are taught by Ball citing Table 1 and the discussion thereof. (Action at page 12). In item 11, entitled "Response to Arguments,"

the Examiner contends that Ball teaches:

a header preceding the message area and a footer following the message area. This can be clearly seen in at least table 1 which opens with "<PML>  
<AUDIO SRC-"inspirational. su" BACKGROUND/>" and ends with "<AUDIO SRC="when. au">,</PML>".

However, TABLE 1 teaches that "<AUDIO SRC-"inspirational. su" BACKGROUND/>" is not a header since the audio discussed is "background," which by definition, and as understood in the art, is not an audio "header" that plays before the main body. (See, for example, col. 8, line 40 in which Ball teaches that "inspirational music plays in the background.")

However, assuming *arguendo* that "AUDIO SRC-"inspirational. su" BACKGROUND/>" does teach a header, Applicant submits that Ball does not teach instead, nor has the Examiner identified as such, "an audio stationary body occurring at least once in said message area in combination with the voice message (emphasis added)" that is separate from the header.

#### **Summary**

Since features recited by claim 26 are not taught by the cited art, the rejection should be withdrawn and claim 26 allowed.

#### **ITEM 4: REJECTION OF CLAIMS 27-28 AND 39 REJECTED UNDER 35 U.S.C. §102(e) AS BEING ANTICIPATED BY GOLD ET AL. (U.S. PAT. PUB. 2002/0032752)**

The Examiner rejects claims 27-28 and 39 under 35 U.S.C. §102(e) as being anticipated by Gold.

Independent claim 27, as amended recites, an apparatus including "a processor, coupled to the storage device, to provide the sound samples to a user and to combine a selected sound sample with the recorded voice message to form a combination message, wherein upon the selected sound sample being selected as background sound and upon determining a time duration of the selected sound sample is less than the a time duration of the selected sound sample the selected sound sample is looped."

Claim 39, as amended, recites a voice mail platform including "means for combining a selected sound sample with a recorded voice message to form a combination message; and means for looping the selected sound sample upon the selected sound sample being a background sound."

The Action concedes that Gold does not teach "the sound sample being background sound." (Action at page 5). The Action also concedes that Gold does not teach "looping the selected sound sample for a time duration equal to a time duration of the recorded voice message." (Action at page 9).

### Summary

Since features recited by claim 27-28 and 39 are not taught by the cited art, the rejection should be withdrawn and claims 27-28 and 39 allowed.

#### **ITEM 5: REJECTION OF CLAIM 43 UNDER 35 U.S.C. §102(e) AS BEING ANTICIPATED BY KAWASHIMA (U.S.P. 6,549,767)**

The Examiner rejects claim 43 under 35 U.S.C. §102(e) as being anticipated by Kawashima.

Claim 43 recites a method of combining sound with a recorded voice message including "prompting the caller to select one of a plurality of sound samples; combining the voice message with the selected sound sample to form a combination message, the selected sound sample being looped for a duration corresponding to a duration of the voice message."

Applicant submits that Kawashima does not teach features including prompting of the caller to select one of a plurality of sound samples and looped for a duration corresponding to a duration of the voice message, in the lines cited or anywhere else.

Kawashima merely teaches (col. 21, lines 38-53) that "a second authoring function makes it possible to add as a background music sound, musical sound data stored in a RAM or the like." That is, Kawashima does not teach a prompting.

Further, Kawashima merely teaches col. 4, lines 37-43 a first mode in which "musical data are looped by a predetermined number of times."

That is, Kawashima by teaching a predetermined number of times a data is looped teaches away from a looping that corresponds, instead, to a duration of a voice message that occurs after a caller has selected one of the sound samples.

### Summary

Since features recited by claim 43 are not taught by the cited art, the rejection should be withdrawn and claim 43 allowed.

#### **ITEM 9: CLAIMS 1-3,7-25,30-38, 40 AND 41 ARE REJECTED UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER GOLD IN VIEW OF BALL**

#### **ITEM 10: REJECTION OF CLAIMS 4 ,5, 6 AND 29 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER GOLD IN VIEW OF GERSZBER (U.S. PAT. PUB. 2001/0050977**

The Examiner rejects claims 1-3, 7-25,30-38, 40 and 41 under 35 U.S.C. 103(a) as being unpatentable over Gold in view of Ball, and rejects dependent claims 4-6 and 29 under 35

U.S.C. §103(a) as being unpatentable over Gold in view of Gerszber.

Independent claim 1, as amended, recites, a method of adding background sound to a voice mail message, including "combining the selected sound sample with a recorded voice message to form a combination message, and looping the selected sound sample as background sound upon determining a time duration of the selected sound sample is less than a time duration of the selected sound sample."

Independent claim 40 recites a method of providing ambient sound to a recorded voice message, including "adding the voice message to the selected sound sample to form a combination message, wherein the sound sample is looped for a duration equaling a duration of the voice message. "

Independent claim 41 recites a method of adding background sound to a greeting, including "combining the selected sound sample with a recorded greeting to form a combination greeting; and looping the background sound."

Applicant submits that features recited by claims are not taught by the cited art, alone or in combination. As provided in MPEP §2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F. 2d 1981, (CCPA 1974)."

The Action concedes that Gold does not teach "looping the selected sound sample for a time duration equal to a time duration of the recorded voice message." (Action at page 9).

However, in item 11 entitled Response to Arguments, the Examiner contends

Ball specifically teaches the opening of the files starts with the background music, as shown in table 1. The generated message plays out in its entirety as the file moves down the list of files that are played consecutively. The background ends at the last step. Ball further reemphasized this in col. 8, lines 40-55 in which background music is played for the duration of the file. Since the background music plays for the entire message then it inherently loops for the duration of the message.

(Action at page 14).

The Examiner contends Ball it would have been obvious "to modify the method of Gold by looping the selected sound sample as taught by Ball."

Applicant submits that the Examiner is incorrect his contention that in Ball the music "inherently loops for the duration of the message." Rather, Ball merely teaches (col. 8, starting at line 45) that "the background music and the audio fragments... are generated by playing the audio files of appropriate names identified in the markup after detaching them from the structured message." (Emphasis added).

Since it is understood in the art that there are many methods of playing background music for a duration of a message, e.g., playing a musical passage of a long duration and stopping the same at an end of a message, Applicant submits there is nothing inherent in a playing of background music as a "looping" of the same.

Further, claims 1 and 41 recite, using claim 1 as an example looping the selected sound sample as "background" sound. Dependent claim 4 recites playing a selected background sound sample to the user while the user records the voice message. Dependent claim 5 recites playing a combination message of background sound and a voice message to a user. Dependent claim 6 recites prompting a user to select one of storing the combination message of background sound and a voice message.

Applicant submits there is no motivation or reasonable chance of success to modify Gold with either Ball or by either as the Examiner contends. As provided in MPEP §2144. 04:

The mere fact that a worker in the art could rearrange the parts of the reference device . . . is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation . . . without the benefit of appellant's specification, to make the necessary changes in the reference device.

Applicants submit that Gold teaches away from a combining as "background" sound. Rather, Gold teaches, see for example, paragraph [0056]

recipient Web client retrieves the voice message 285 from the dedication Web server using the voice message URL located in the dedication client script. The Web client plays the voice message 284 for the recipient. The recipient Web client continues to execute 286 the dedication client script and retrieves 295 the dedicated song from the jukebox server using the URL of the dedicated song located in the dedication client script. The recipient Web client plays 288 the song for the recipient. This completes the dedication replay process.

Further, features recited by the dependent claims are not taught by cited art, alone or in combination. For example, claim 15 includes a method including " the recipient forwarding the separated recorded voice message without the selected sound sample to the third-party recipient." The Examiner contends this feature is taught by Gold paragraph [0066]. However Gold merely teaches a "recipient CT client plays the voice message and the song completing the dedication."

Gold does not teach, alone or in combination, a user and a recipient, wherein the recipient forwards a message to another third-party recipient.

### **Summary**

Since *prima facie* obviousness is not established, the rejections should be withdrawn and claims 1-25, 29-38, 40 and 41 allowed.

**CONCLUSION**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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